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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,727	07/09/2003	Mark A. Reiley	9448.17205-CIP DIV	1799
21971	7590	12/01/2004	EXAMINER	
WILSON SONSINI GOODRICH & ROSATI			ISABELLA, DAVID J	
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PALO ALTO, CA 943041050			PAPER NUMBER	

3738

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,727

Applicant(s)

REILEY, MARK A.

Examiner

DAVID J ISABELLA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6-14 and 32-74 is/are pending in the application.
- 4a) Of the above claim(s) 8,9,12,32,33,51-53,56 and 57 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 44-50,54,55 and 58-61 is/are allowed.
- 6) ☒ Claim(s) 1,6,7,10,11,13,14,34-43 and 62-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Claims 8,9,12,32,33,51-53,56,57 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 9/13/2004.

Applicant's election without traverse of figure 25 in the reply filed on 9/13/2004 is acknowledged.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 34-43,67-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This application is a divisional of parent application 09/693272. The subject matter directed to the language of "said prosthesis is configured so that no portion of said prosthesis contacts the posterior arch of said vertebra" finds no clear support in applicant's specification. Accordingly, these claims are directed to newly presented

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subject matter. Accordingly, the claims will be rejected over US Patent 6,579,319 from which the claims were copied.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 34-43,67-70 are rejected under 35 U.S.C. 102(b) as being anticipated by Goble et al (6,579,319).

These claims were copied from the patent. Since applicant's specification does not clearly support the language of "said prosthesis is configured so that no portion of said prosthesis contacts the posterior arch of said vertebra", these claims are anticipated by Goble, et al.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,6,7,10,11,13,14 are rejected under 35 U.S.C. 102(b) as being anticipated by either of Martin (6132464) or Fitz (Re36578).

Each of Martin and Fitz disclose a prosthesis to replace a cephalad portion of a left natural facet joint on a vertebral body and a cephalad portion of a right natural facet joint on the vertebral body, the prosthesis comprising left and right prosthesis bodies accommodating fixation to the vertebral body at or near respective left and right pedicles without support of a lamina, an artificial left facet joint structure on the left prosthesis body adapted and configured to replace a cephalad portion of the left natural facet joint, and an artificial right facet joint structure on the right prosthesis body adapted and configured to replace a cephalad portion of the right natural facet joint.

Examiner is interpreting the language of the claim as a structure. The manner in which the implant is used does not materially affect the structure of the device as broadly worded.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 62,63 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by any of Laure (4040130), Johnson, et al (4156296) and Lewis (4231121).

Examiner is interpreting the language of the claim as a structure. The manner in which the implant is used does not materially affect the structure of the device as broadly worded; and these devices are structurally similar to the device employed by applicant, that they would be capable of being utilized in the manner as claimed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 64 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of Laure, Johnson, et al and Lewis as applied to claim 62 above, and further in view of Brosnaham III (5766253).

The use of a porous coating in combination with bioactive agents including osteoinductive and osteoconductive material in combination with an implant to be adhered to the interior of the bone is well known as taught by Brosnaham III. To provide the implants of Laure, Johnson, et al and Lewis with means for attaching the implant securely in the interior volume of a bone by means of a porous coating with bioactive agents therein would have been obvious to one with ordinary skill in the art from the teachings of Brosnaham III.

Allowable Subject Matter


Claims 44-50,54,55,58-61 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-THURSDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J ISABELLA
Primary Examiner
Art Unit 3738

DJI
November 29, 2004